

PATENT**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:

Pieter Aquarius et al.

Application No. 10/031,111

Filed: January 8, 2002

For: DEVICE FOR
MANUFACTURING CUSHIONS
FILLED WITH A MEDIUM,
SERIES OF CUSHIONS AND
CUSHION MANUFACTURED
BY SUCH A DEVICE, AND
TUBULAR FOIL

Group Art Unit: Not Assigned

Examiner: Not Assigned

Atty Docket: 006759.00034

THIRD RENEWED PETITION UNDER 37 C.F.R. § 1.47(b)

Mail Stop PCT
Office of PCT Legal Administration
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

This paper is responsive to the Decision on Second Renewed Petition Under 37 C.F.R. § 1.47(b) mailed March 1, 2005, for which a two-month period for response has been set, *i.e.*, up to and including May 1, 2005. It is believed that no fee is due for this submission. However, the Commissioner is authorized to debit our Deposit Account 19-0733 for any fee required.

Applicant notes with appreciation that the March 1, 2005 Decision indicates that the averments of Messrs. Wright and Graham are sufficient to show that the inventors refused to sign the declaration and the assignment. The March 1, 2005 Decision indicates that Applicant has met the requirements of 37 C.F.R. § 1.47(b) except for demonstrating a sufficient proprietary

interest in the application. The Decision also indicates that Applicant need only establish a proprietary interest from either Mr. Straver or Mr. Aquarius in order to prosecute the application.

Background

The subject matter of the present application was developed under an October 3, 1997 joint research agreement between Flo-Pak BV, a subsidiary of Free-Flow Packaging International, Inc. ("Free-Flow") and Case Packaging Sales Europe BV ("CPS"). The agreement provided the parties jointly own intellectual property rights to technology developed under the agreement. The agreement also provided that an uncured breach by either party would result in transfer of the jointly owned intellectual property rights to the non-breaching party. The agreement was terminated in October 2001, and litigation over the agreement presently is ongoing in the Netherlands between Free-Flow and CPS. CPS asserts that ownership of this application should be awarded to CPS. Free-Flow asserts that ownership should be awarded to Free-Flow. In any event, Applicant respectfully requests that this application be accepted under 37 C.F.R. § 1.47(b) to preserve the *status quo* and to avoid prejudice to whichever party is ultimately awarded ownership of this application. A request for suspension of action under 37 C.F.R. § 1.103 is submitted concurrently herewith.

Free-Flow's Proprietary Interest in the Application

One of the inventors, Pieter Aquarius, is a principal of CPS. The other inventor, Frederik Straver, was an employee of Flo-Pak at the time the invention was made. (see February 27, 2004 Graham Dec. ¶ 5). The March 1, 2005 Decision acknowledges that Mr. Straver's employment agreement with Flo-Pak BV provides that "[a]ll such inventions, discoveries or designs shall be transferred to the Company upon written request of the employer." (Exhibit P, Section 11). The March 1, 2005 Decision indicates, however, "Applicant has not provided this written request to

show that there has been a transfer.” Apparently, the Decision recognizes that Mr. Straver had an obligation to assign inventions to the Company if a written request was made by the company, but is of the position that Applicant has not shown that such a written request had been made.

Around the time this application was filed, Free-Flow’s attorney Edward Wright was corresponding with Mr. Straver through a Dutch attorney in efforts to get Mr. Straver to sign the declaration and to transfer his interest to Free-Flow. (February 27, 2004 Graham Dec. ¶ 6). Exhibit B is a letter from Mr. Wright to Octrooibureau Vriesendorp & Gaade asking that Mr. Straver execute a declaration and an assignment. Exhibit C is an e-mail dated December 21, 2001 from Mr. Wright’s secretary to the Vriesendorp firm forwarding the declaration and assignment documents electronically. Newly submitted Exhibit Q is a copy of the assignment that was included with the December 21, 2001 letter and e-mail. (Third Supplemental Statement of Wright ¶ 1). After the application was filed, the inventors were again asked by letter dated April 29, 2002 (Exhibit E) to execute declaration and assignment documents.¹ Newly submitted Exhibit R is the assignment that was included with the April 29, 2002 letter. (Third Supplemental Statement of Wright ¶ 2). Because rights to the invention are jointly held by CPS and Free-Flow, the assignment instrument conveys title to both CPS and Free-Flow (with Mr. Aquarius’ interest being transferred to CPS and Mr. Straver’s interest being transferred to Free-Flow). By these written communications, Mr. Straver was asked to “sell, assign, transfer and convey unto said Assignees, the entire right, title and interest (a) in and to said application and said invention...” (Exhibit Q; Exhibit R).

The March 1, 2005 Decision indicates that the December 21, 2001 and April 29, 2002 communications between Mr. Wright and the Dutch attorney are sufficient to show that the inventors were presented with (but refused to sign) the declaration. Likewise, these same

¹ For convenience, copies of previously submitted Exhibits B, C, and E are attached.

communications demonstrate that Mr. Straver was contemporaneously presented with and asked to sign an assignment, i.e., Mr. Straver was presented with a written request to transfer his interest in the invention to Free-Flow. Under his employment agreement, Mr. Straver was under an obligation to transfer his interest in the invention to Free-Flow, at least by this time because a written request had been formally made by Free-Flow through its attorney. (Exhibit P, Section 11).

Conclusion

Applicant has demonstrated Free-Flow's proprietary interest in this application at least because (1) co-inventor Frederik Straver was under an obligation to assign the invention to Free-Flow upon Free-Flow's written request, and (2) Free-Flow made a written request to Mr. Straver to assign his rights in the invention to Free-Flow.

WHEREFORE, Applicant respectfully requests that the petition under 37 C.F.R. § 1.47(b) be granted and the application be accepted.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Date: May 2, 2005

1001 G Street N.W.
Washington, DC 20001-4597
(202) 824-3000 (telephone)
(202) 824-3001 (facsimile)

By: 

Joseph M. Potenza
Registration No. 28,175
Paul M. Rivard
Registration No. 43,446
Attorneys for Free-Flow
Packaging International, Inc.

cc: F. A. L. Kamps
Herman A. Whitmans
(attorneys for Case Packaging Sales Europe BV)

EXHIBIT B

FLEHR HOECHST ALBRITTON & HERBERT LLP**FACSIMILE COMMUNICATION****FAX (650) 494-8771****TELEPHONE (650) 494-8700**

December 21, 2001

TO: OCTROOIBUREAU VRIESENDORP & GAADE
FAX: 011-31-70-3646793
FROM: EDWARD S. WRIGHT
PAGES TRANSMITTED: 5

Re: Case Packing Sales Europe B.V.
and Free-Flow Packaging International, Inc.
U.S. National Phase Application Corresponding to
PCT Patent Application No. PCT/NL01/00351
**DEVICE FOR MANUFACTURING CUSHIONS FILLED
FILLED WITH A MEDIUM, SERIES OF CUSHIONS
AND CUSHION MANUFACTURED BY SUCH A DEVICE,
AND TUBULAR FOIL**
Your Ref: USP165429
Our File A-71253/ESW

Gentlemen:

As requested in your letter of December 19, we are enclosing a Combined Declaration and Power of Attorney and an Assignment for use in filing the application in the United States. These documents are also being sent to you by email.

In order to meet the January 8, 2002 filing deadline, we will need to have the signed documents back no later than that date. As you may know, the U.S. Patent Office will now accept facsimile copies of such documents as long as you also send us the copies with the original signatures for retention in the file in case they should ever be requested.

We now have a complete copy of the international application, so you will not need to send that to us. However, we do need the international search report. Please fax a copy of that report to us as soon as possible. In addition, please let us know if the claims were amended under PCT Article 19.

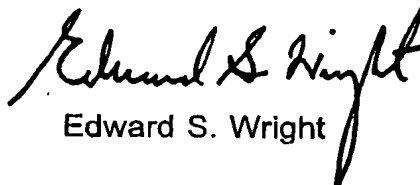
850 HANSEN WAY, SUITE 200, PALO ALTO, CALIFORNIA 94304-1017

Octrooibureau Vriese... & Gaade
December 21, 2001
Page 2

All facsimile communications regarding this matter should be sent directly to my attention at our Palo Alto office, (650) 494-8771.

Very truly yours,

FLEHR HOHBACH TEST
ALBRITTON & HERBERT LLP



Edward S. Wright

ESW:mlc
Enclosures

cc: Mr. Arthur Graham

EXHIBIT C

Cerimeli, Marie

From: Cerimeli, Marie
Sent: Friday, December 21, 2001 3:43 PM
To: 'patnl@vriesendorp.nl'
Subject: Your Ref.: USP165429

Gentlemen:

As requested in your letter of December 19, we are enclosing a Combined Declaration and Power of Attorney and an Assignment for use in filing the application in the United States.

In order to meet the January 8, 2002 filing deadline, we will need to have the signed documents back no later than that date. As you may know, the U.S. Patent Office will now accept facsimile copies of such documents as long as you also send us the copies with the original signatures for retention in the file in case they should ever be requested.

We now have a complete copy of the international application, so you will not need to send that to us. However, we do need the international search report. Please fax a copy of that report to us as soon as possible. In addition, please let us know if the claims were amended under PCT Article 19.

All facsimile communications regarding this matter should be sent directly to Mr. Wright's attention at our Palo Alto office, (650) 494-8771.

Marie L. Cerimeli
for Edward S. Wright
FLEHR HOHBACH TEST
ALBRITTON & HERBERT LLP
850 Hansen Way, Suite 200
Palo Alto, CA 94304-1017
Telephone: (650) 494-8700
Facsimile: (650) 494-8771



Assignment.doc
Declaration and Power
of Attor...

EXHIBIT E

FLEHR HOHBACH TEST ALBRITTON & HERBERT LLP
ATTORNEYS AT LAWEDWARD S. WRIGHT
(Palo Alto Office)

PATENTS, TRADEMARKS, COPYRIGHTS

FOUR EMBARCADERO CENTER
SUITE 3400
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(415) 781-1989

850 HANSEN WAY
SUITE 200
PALO ALTO, CA 94304-1017(650) 494-8700
FAX: (650) 494-8771

April 29, 2002

VIA AIRMAIL

OCTROOIBUREAU VRIESENDORP & GAADE
Postbus 266
NL-2501 AW Den Haag
THE NETHERLANDS

Re: Case/Free-Flow U.S. Patent Application
**DEVICE FOR MANUFACTURING CUSHIONS FILLED
FILLED WITH A MEDIUM, SERIES OF CUSHIONS
AND CUSHION MANUFACTURED BY SUCH A DEVICE,
AND TUBULAR FOIL (PCT/NL01/00351)**
Your Ref: USP165429
Our File A-71266/ESW (formerly A-71253/ESW)

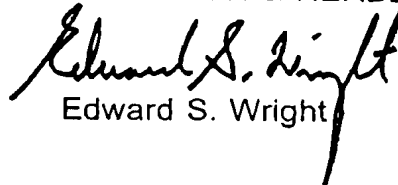
Gentlemen:

The Patent Office has now asked us to submit the formal papers which are required to complete the filing of this application, and the deadline for doing so is June 17, 2002. We have, therefore, prepared and are enclosing declaration, assignment and power of attorney papers for the application. If satisfactory, these should be signed as indicated by Messrs. Aquarius and Straver and returned to us for submission to the U.S. Patent Office.

Also enclosed is a copy of an information disclosure statement which has been submitted to the U.S. Patent Office. We trust that you will advise us of any pertinent prior art that you may be aware of and that you will send us copies of any references which have been already cited in corresponding applications in other countries.

Please let us know if there are any questions about the enclosed papers.

Very truly yours,

FLEHR HOHBACH TEST
ALBRITTON & HERBERT LLP
Edward S. WrightESW:mlc
Enclosures

cc: Mr. Arthur Graham (w/encls)

EXHIBIT Q

ASSIGNMENT

WHEREAS, the undersigned, Pieter Theodorus Joseph Aquarius and Frederik Cornelis Martinus Straver, (hereinafter termed "Inventors"), residents respectively of Stramproy, The Netherlands and Laren, The Netherlands, have invented certain new and useful improvements in **DEVICE FOR MANUFACTURING CUSHIONS FILLED WITH A MEDIUM, SERIES OF CUSHIONS AND CUSHION MANUFACTURED BY SUCH A DEVICE, AND TUBULAR FOIL**, and have executed concurrently herewith an application for a United States patent disclosing and identifying the invention; and

WHEREAS, Case Packing Sales Europe B.V., a corporation of The Netherlands, having a place of business at Industrieweg 24, NL-6039 AP Stramproy, The Netherlands, and Free-Flow Packaging International, Inc., a corporation of the State of Delaware, having a place of business at 1090 Mills Way, Redwood City, State of California, (hereinafter termed "Assignees"), are desirous of acquiring the entire right, title and interest in and to said application and the invention disclosed therein, and in and to all embodiments of the invention, heretofore conceived, made or discovered by said Inventors (all collectively hereinafter termed "said invention"), and in and to any and all patents, inventors' certificates and other forms of protection (hereinafter termed "patents") thereon granted in the United States and foreign countries.

NOW, THEREFORE, in consideration of good and valuable consideration acknowledged by said Inventors to have been received in full from said Assignees:

1. Said Inventors do hereby sell, assign, transfer and convey unto said Assignees, the entire right, title and interest (a) in and to said application and said invention; (b) in and to all rights to apply for foreign patents on said invention pursuant to the International Convention for the Protection of Industrial Property or otherwise; (c) in and to any and all applications filed and any and all patents granted on said invention in the United States or any foreign country, including each and every application filed and each and every patent granted on any application which is a division, substitution, or continuation of any of said applications; and (d) in and to each and every reissue or extensions of any of said patents.

2. Said Inventors hereby covenant and agree to cooperate with said Assignees to enable said Assignees to enjoy to the fullest extent the right title and interest herein conveyed in the United States and foreign countries. Such cooperation by said Inventors shall include prompt production of pertinent facts and documents, giving of testimony, execution of petitions, oaths, specifications, declarations or other papers, and other assistance all to the extent deemed necessary or desirable by said Assignees (a) for perfecting in said Assignees the right, title and interest herein conveyed; (b) for prosecuting any of said applications; (c) for filing and prosecuting substitute, divisional, continuing or additional applications covering said invention; (d) for filing and prosecuting applications for reissuance of any said patents; (e) for interference or other priority proceedings involving said invention; and

(f) for legal proceedings involving said invention and any applications therefor and any patents granted thereon, including without limitation opposition proceedings, cancellation proceedings, priority contests, public use proceedings, infringement actions and court actions; provided, however, that the expense incurred by said Inventors in providing such cooperation shall be paid for by said Assignees.

3. The terms, covenants and conditions of this assignment shall inure to the benefit of said Assignees, their successors, assigns and other legal representatives, and shall be binding upon said Inventors, their heirs, legal representatives and assigns.

4. Said Inventors hereby warrant and represent that they have not entered and will not enter into any assignment, contract, or understanding in conflict herewith.

IN WITNESS WHEREOF, said Inventor has executed and delivered this instrument to said Assignees this ____ day of _____.

Pieter Theodorus Joseph Aquarius

IN WITNESS WHEREOF, said Inventor has executed and delivered this instrument to said Assignees this ____ day of _____.

Frederik Cornelis Martinus Straver

EXHIBIT R

ASSIGNMENT

WHEREAS, the undersigned, Pieter Theodorus Joseph Aquarius and Frederik Cornelis Martinus Straver, (hereinafter termed "Inventors"), residents respectively of Stramproy, The Netherlands and Laren, The Netherlands, have invented certain new and useful improvements in **DEVICE FOR MANUFACTURING CUSHIONS FILLED WITH A MEDIUM, SERIES OF CUSHIONS AND CUSHION MANUFACTURED BY SUCH A DEVICE, AND TUBULAR FOIL**, and have executed an application for a United States patent disclosing and identifying the invention; and having Serial No. 10/031,111 and filing date of January 8, 2002; and

WHEREAS, Case Packing Sales Europe B.V., a corporation of The Netherlands, having a place of business at Industrieweg 24, 6039 AP Stramproy, The Netherlands, and Free-Flow Packaging International, Inc., a corporation of the State of Delaware, having a place of business at 1090 Mills Way, Redwood City, State of California, (hereinafter termed "Assignees"), are desirous of acquiring the entire right, title and interest in and to said application and the invention disclosed therein, and in and to all embodiments of the invention, heretofore conceived, made or discovered by said Inventors (all collectively hereinafter termed "said invention"), and in and to any and all patents, inventors' certificates and other forms of protection (hereinafter termed "patents") thereon granted in the United States and foreign countries.

NOW, THEREFORE, in consideration of good and valuable consideration acknowledged by said Inventors to have been received in full from said Assignees:

1. Said Inventors do hereby sell, assign, transfer and convey unto said Assignees, the entire right, title and interest (a) in and to said application and said invention; (b) in and to all rights to apply for foreign patents on said invention pursuant to the International Convention for the Protection of Industrial Property or otherwise; (c) in and to any and all applications filed and any and all patents granted on said invention in the United States or any foreign country, including each and every application filed and each and every patent granted on any application which is a division, substitution, or continuation of any of said applications; and (d) in and to each and every reissue or extensions of any of said patents.

2. Said Inventors hereby covenant and agree to cooperate with said Assignees to enable said Assignees to enjoy to the fullest extent the right title and interest herein conveyed in the United States and foreign countries. Such cooperation by said Inventors shall include prompt production of pertinent facts and documents, giving of testimony, execution of petitions, oaths, specifications, declarations or other papers, and other assistance all to the extent deemed necessary or desirable by said Assignees (a) for perfecting in said Assignees the right, title and interest herein conveyed; (b) for prosecuting any of said applications; (c) for filing and prosecuting substitute, divisional, continuing or additional applications covering said invention; (d) for filing and prosecuting applications for reissuance of any said

patents; (e) for interference or other priority proceedings involving said invention; and (f) for legal proceedings involving said invention and any applications therefor and any patents granted thereon, including without limitation opposition proceedings, cancellation proceedings, priority contests, public use proceedings, infringement actions and court actions; provided, however, that the expense incurred by said Inventors in providing such cooperation shall be paid for by said Assignees.

3. The terms, covenants and conditions of this assignment shall inure to the benefit of said Assignees, their successors, assigns and other legal representatives, and shall be binding upon said Inventors, their heirs, legal representatives and assigns.

4. Said Inventors hereby warrant and represent that they have not entered and will not enter into any assignment, contract, or understanding in conflict herewith.

IN WITNESS WHEREOF, said Inventor has executed and delivered this instrument to said Assignees this ____ day of _____.

Pieter Theodorus Joseph Aquarius

IN WITNESS WHEREOF, said Inventor has executed and delivered this instrument to said Assignees this ____ day of _____.

Frederik Cornelis Martinus Straver

PATENT**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:

Pieter Aquarius et al.

Application No. 10/031,111

Filed: January 8, 2002

For: DEVICE FOR
MANUFACTURING CUSHIONS
FILLED WITH A MEDIUM,
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BY SUCH A DEVICE, AND
TUBULAR FOIL

Group Art Unit: Not Assigned

Examiner: Not Assigned

Atty Docket: 006759.00034

**THIRD SUPPLEMENTAL STATEMENT OF EDWARD S. WRIGHT
IN SUPPORT OF PETITION UNDER 37 C.F.R. § 1.47(b)**

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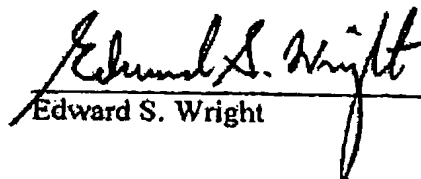
I, Edward S. Wright, hereby declare and state as follows.

1. As stated in ¶ 2 of my first Statement in Support of Petition to File Application Under 37 C.F.R. § 1.47(b) dated October 16, 2002, I faxed declaration, assignment and power of attorney papers to Vriesendorp along with a letter dated December 21, 2001 (Exhibit B), requesting that the papers be signed by the inventors and returned for filing with the application. Attached Exhibit Q is a copy of the assignment that was sent to Vriesendorp with the December 21, 2001 letter (Exhibit B).

2. As stated in ¶ 5 of my October 16, 2002 statement, I sent new declaration, assignment and power of attorney papers to Vriesendorp with a letter (Exhibit E) requesting that the papers be signed by the inventors and returned for filing with the application. I sent this letter to Vriesendorp on April 29, 2002. Attached Exhibit R is a copy of the assignment that was sent to Vriesendorp with the April 29, 2002 letter (Exhibit E).

I further declare that all statements made herein of my knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date: May 2, 2005


Edward S. Wright